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OFFICE OF PETITIONS

In re Application of
Harshfield et al.
Application No. 09/853,233
Filed: May 11, 2001
Attorney Docket No. M4065.0743/P743

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DECISION ON PETITION

This is a decision on the petition filed March 9, 2005, to withdraw the holding of abandonment under 37 CFR 1.181 or, in the alternative, a petition under 37 CFR 1.137(b) to revive the application. The petition was recently forwarded to the Office of Petitions for a decision on the merits. The Office sincerely apologizes for any inconvenience.

The application became abandoned on November 26, 2004, for failing to file a timely reply to the Notice of Allowance and Fee(s) Due mailed on August 25, 2004. A Notice of Abandonment was mailed on February 18, 2005.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

On May 11, 2004, petitioners paid the issue fee and the publication fee in response to the First Notice of Allowance mailed on March 9, 2004. On June 17, 2004, petitioners filed a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee. The petition was granted by the decision of June 29, 2004, which stated that the application was withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). Furthermore, petitioners were advised that the issue fee paid on May 11, 2004, could not be refunded; however, petitioners could request that it be applied to the issue fee required by a new Notice of Allowance, if the application was again allowed. The decision informed petitioners that the request to apply the issue fee to the new Notice of Allowance could be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b). Lastly, the decision advised petitioners that, whether or not the Notice of Allowance indicated that a fee was due, the Issue Fee Transmittal Form PTOL-85(b) **MUST** be completed and timely submitted to avoid abandonment. Moreover, the Second Notice of Allowance stated in bold language that the PTOL-85(b) (or an equivalent) **MUST** be returned within the period indicated, even if no fee is due, or the application will be regarded abandoned.

In the present petition, petitioners averred that the above-identified application is not abandoned because a timely response was filed on November 23, 2004, in response to the Notice of Allowance. Petitioners explained that telephonic conferences were conducted with the Examiner on November 23, 2004, concerning an erroneous Examiner's Statement for Reasons of Allowance. Petitioners asserted that the Examiner requested that they file a statement noting the error and indicating that the Declarations filed on October 14, 2003, and December 23, 2003, were not Rule 131 or 132 Declarations, respectively. Petitioners further asserted that the Examiner indicated that he would immediately withdraw the application from issue and re-open prosecution to consider the Declarations more fully. Petitioners stated that they submitted a "Confirmation of Telephonic Conferences With Examiner Coleman on November 23, 2004 With Accompanying Comments" via facsimile transmission on November 23, 2004.

The record reveals that on December 10, 2004, the Examiner mailed a "Response to Rule 312 Communication," indicating that the Examiner had considered and entered the amendment under, 37 CFR 1.312 filed on October 25, 2004.

Initially, the Office notes that all business with the USPTO should be transacted in writing pursuant to 37 CFR 1.2. The action of the USPTO will be based exclusively on the written record in the Office. See 37 CFR 1.2 "No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." Id. The Office further notes that "[u]nless applicant receives a written communication from the Office that the application has been withdrawn from issue, the issue fee must be timely submitted to avoid abandonment." MPEP 1308(I)(A). Lastly, an applicant may file a statement commenting on his position if he disagrees with the reasons for allowance, preferably no later than the payment of the issue fee. See MPEP 1302.14. However, while the Examiner may review and comment upon an applicant's statement, the Examiner has no obligation to do so. Id.

Nevertheless, an applicant of a patent application is required to reply to an Office action within the time period set forth in that action to avoid abandonment of the application. See 37 CFR 1.135. In this instance, the Notice of Allowance (PTOL-85) required petitioners to reply to the Notice by returning the PTOL-85b (or an equivalent)¹ within three months of the mailing date, even if no fee was due, or the application would be regarded as abandoned. Although petitioners paid the issue fee in response to the First Notice of Allowance, petitioners were required to respond to the Second Notice of Allowance of August 25, 2004. Yet, the record indicates that petitioners did not take the appropriate action of returning the PTOL-85B (or an equivalent) within the three-month statutory period. The showing of record is insufficient to warrant withdrawal of the holding of abandonment. Accordingly, the petition to withdraw the holding of abandonment is **dismissed**.

PETITION UNDER 37 CFR 1.137(b)

In the alternative, petitioners requested that the Office revive the application due to unintentional abandonment. The provisions of 37 CFR 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

¹ The Office does not equate the Response of November 23, 2004, as an equivalent of the PTOL-85B.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" be submitted. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioners must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

Petitioners have met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Accordingly, the petition under 37 CFR 1.137(b) is granted.

The Office will charge the Deposit Account for the \$1,500.00 petition fee, as authorized.

This matter is being referred to the Office of Patent Publication for processing into a patent.

Telephone inquiries concerning the issuance of the application into a patent should be directed to the Office of Patent Publication, Customer Service at (571) 272-4200. Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3211.

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